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In re Application of :
ARBIT et al. :
Application No. 10/500,822 :
PCT No.: PCT/US03/00337 : DECISION ON PETITION
Int. Filing Date: 07 January 2003 :
Priority Date: 07 January 2002 : UNDER 37 CFR 1.181
Attorney Docket No.: 817.110US :
For: ORAL INSULIN THERAPY :

This decision is in response to applicants' "Response to Notification of Missing Requirements and Request to Correct Inventor's Name" filed 18 October 2004, which is being treated as a Petition under 37 CFR 1.181.

BACKGROUND

On 07 January 2003, applicants filed the above identified international application which claimed priority date of 07 January 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 07 July 2004.

On 07 July 2004, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international; and a copy of a Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) filed during the international phase.

On 08 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requesting clarification of the fourth inventor's name.

On 18 October 2004, applicants filed "Response to Notification of Missing Requirements and Request to Correct Inventor's Name."

DISCUSSION

A. Sequence Listing

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 08 September 2004 indicated that the nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements set forth in 37 CFR 1.821-1.825. Applicants state, "the referenced application does not include a nucleotide and/or amino acid sequence disclosure." Applicants' assertion is correct that there is no need to file a sequence listing for the present application. As such, the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 08 September 2004 is vacated in part.

B. Defective Declaration

A review of the application reveals that the declaration (Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) for the purposes of the designation of the United States of America) is not in compliance with 37 CFR 1.497(a)-(b). The declaration is not directed to an international application. Additionally, there is an issue as to whether the declaration has been properly executed. The declaration filed with the petition includes a duplicate signature block for the third, fourth, fifth and sixth inventor. It is unclear if these inventors were presented with that page, in which case the execution would be improper, or if they were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document, which is also improper. (See Administration Instruction under the Patent Cooperation Treaty Section 214(b) and MPEP 201.03.)

C. Name Change

Applicants state in the present response that the correct name of the fourth inventor's name is T. Cooper Woods as indicated on the declaration rather than Cooper T. Woods as indicated on the published international application. As indicated in Section 201.03 of the Manual of Patent Examining Procedure, where a typographical or transliteration error in the spelling of an inventor's name is discovered, a petition under 37 CFR 1.48 is not required. Accordingly, applicant's explanation of the difference in the spelling of the fourth inventor's name is accepted and noted for the record.

CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box
1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the
attention of the Office of PCT Legal Administration.

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